

REMARKS

The Office Action of June 19, 2007 has been carefully considered. Reconsideration of this application, as amended, is respectfully requested.

Claims 1 – 13 and 20 are pending.

Turning now, to the office action, claims 1-13 and 20 were rejected under 35 USC §112, first paragraph, as failing to comply with the written description requirement. Claims 1-5, 7-10 and 20 were rejected under 35 USC §103(a) as being unpatentable over Shaw et al. (6,033,146) in view of Danielsson (4,281,496) or newly cited Harvey (6,566,146). Claim 11 was rejected under 35 USC §103(a) as being unpatentable over Shaw et al. (6,033,146) in view of Danielsson (4,281,496) or Harvey (6,566,146) and further in view of Surface Preparation. Claim 12 was rejected under 35 USC §103(a) as being unpatentable over Shaw et al. (6,033,146) in view of Danielsson (4,281,496) or Harvey (6,566,146) and further in view of Surface Preparation and still further in view of Jones (6,454,632). Claim 13 was rejected under 35 USC §103(a) as being unpatentable over Shaw et al. (6,033,146) in view of Danielsson (4,281,496) or Harvey (6,566,146) and further in view of Chiuminatta (5,088,750).

Traversal of Rejection under 35 USC §112, first paragraph

Turning now, to the office action, claims 1-13 and 20 were rejected under 35 USC §112, first paragraph, as failing to comply with the written description requirement. First, the claims were rejected for use of the term “non-cementitious” as a further limitation for the descriptive aggregate set forth in the claims. As MPEP §2163.02 specifically states, “[t]he subject matter of the claim need not be described literally (i.e., using the same terms or in *haec verba*) in order for the disclosure to satisfy the description requirement.” Moreover, the Examiner bears the burden of establishing a *prima facie* basis for the rejection, by providing reasons why a person skilled in the art at the time the application was filed would not have recognized that the inventor was in possession of the invention as claimed in view of the disclosure of the application as filed. Applicants note that no such statement or reasons have been supplied by the Examiner. Moreover, the term cementitious was used in characterizing not only concrete (p. 2; “Concrete is a cementitious [sic] building material created by combining a mineral filler such as sand and gravel or similar aggregate with a binding agent, such as Portland cement, and water.”), but also in

describing the manner of producing terrazzo floors (p. 3). In the Detailed Description, Applicants set forth various examples of decorative aggregates (e.g., p. 7, lines 9-13) – none of which include a binding agent such as Portland cement. Thus, the exemplary decorative aggregates listed clearly set forth a number of non-cementitious aggregates – establishing that Applicants had possession of the claimed invention. Applicants respectfully submit that a person skilled in the art would recognize in the disclosure a description of the invention defined by the claims (e.g., non-cementitious decorative aggregate). *Wertheim*, 541 F.2d at 263, 191 USPQ at 97.

Second, claim 20 was rejected for the use of the transitional phrase “consisting of.” The Examiner has urged in the rejection that the inventor(s) had possession of the claimed steps of the invention (acknowledging support exists for the same claim limitations when set forth in claim 1), but nonetheless rejects the claim because of the transitional phrase employed. Using the closed transition phrase “consisting of” (MPEP §211.03) excludes any step not specified in the claim. Clearly, Fig. 1 (“flowchart depicting the steps utilized in producing the concrete floor with terrazzo-like surface in accordance with the present invention”; p. 5) sets forth the recited steps and demonstrates that the Applicants were in the possession of the claimed invention. Accordingly, Applicants demonstrated that the recited steps were those believed required to complete the invention. The fact that Applicants have chosen to characterize method claim 20 in a manner employing a closed transitional phrase, covering steps acknowledged to have been set forth in the application, is not a proper basis for the current rejection. Moreover, the Examiner has again failed to establish a *prima facie* basis for the rejection, by providing reasons why a person skilled in the art at the time the application was filed would not have recognized that the Applicants were in possession of the invention as claimed in view of the disclosure in the application.

In view of the Examiner’s failure to set forth adequate basis for the rejection, and in light of the support for the claims as described in the above argument, Applicants respectfully traverse the rejection under 35 USC §112, first paragraph and request that the rejection be acknowledged as withdrawn.

Traversal of rejections under 35 USC §103(a)

Claims 1-5, 7-10 and 20 were rejected under 35 USC §103(a) as being unpatentable over Shaw et al. (6,033,146) in view of Danielsson (4,281,496) or newly cited Harvey (6,566,146). The rejection is respectfully traversed. The disclosures of the cited art and the distinctions between Shaw and Danielsson or Harvey may be briefly summarized as follows:

As previously presented by Applicants, Shaw discloses a surface-seeded, exposed particulate concrete. Relative to surface seeding/exposure, Shaw teaches at col. 1, lines 22-48, that the exposure of aggregate leads to surface roughness when large aggregate is used and precludes use of the technique in flooring. This statement alone suggests that Shaw's teaching of exposed particulate arises through the removal of concrete material, and not the particulate. In other words, such teaching indicates that the aggregate exposure taught by Shaw does not remove the aggregate material itself (no more than 5%; col. 4, lines 36-50), but exposes the surface of such aggregate. Such a teaching is contrary to the presently claimed invention and thus teaches away from the limitations set forth in the claims. While Shaw does suggest that sandblasting, acid etching or grinding and polishing may also be used to create texture variations (col. 4, lines 63-65), Applicants understand these treatments to be selective treatments to create texture variations, which would appear to further teach away from the present invention – a generally planar and smooth surface.

Amended claim 1 specifically recites, in order, preparing and forming the region to be poured, contiguously pouring concrete in the region, floating the concrete, allowing the concrete to cure to a semi-stiff state, finishing the exposed upper surface of the concrete to a generally planar surface, disbursing decorative aggregate over only the surface, and integrating the aggregate into the upper surface of the semi-stiff concrete. These steps are then followed by partially curing the concrete with the integrated aggregate, grinding the upper surface of the partially cured concrete having the integrated aggregate therein, including partially removing some of the partially cured concrete with the integrated aggregate material at least until the aggregate is exposed uniformly over the top of the concrete, fully curing the concrete with the integrated aggregate, and polishing the upper surface with the integrated

aggregate to provide a generally planar and smooth surface on the monolithic concrete floor.

Several of the recited steps and limitations of claims 1 and 20 are not taught by Shaw. The Examiner has acknowledged that Shaw does not teach the recited grinding step, nor is the recited order of the steps disclosed by Shaw. Furthermore, Shaw teaches away from grinding the upper surface until aggregate is exposed uniformly as Shaw is directed to exposing the natural surface of the aggregate (“revealing the top surface of the embedded particulates 18”; col. 4, lines 41-50). Shaw not only fails to teach partially curing the concrete followed by grinding the upper surface of the partially cured concrete, including removing some integrated aggregate material at least until the aggregate is exposed uniformly over the top of the concrete, but it is clear that Shaw intends for the top surface of aggregate in the uncured concrete to be exposed using non-grinding steps (water, sponge, broom; col. 4, lines 44-49). Thus, Shaw clearly teaches away from a grinding of the aggregate in partially cured concrete. While Shaw does disclose various methods “to create texture variations on the surface” (col. 4, lines 60-65), Applicants respectfully maintain that this does not give rise to the teaching alleged by the Examiner.

Once again the Examiner improperly relies upon Danielsson in combination with Shaw. First, Danielsson expressly teaches away from the use of troweling or finishing of the concrete (col. 3, lines 30-35; col. 7, lines 55-65) but uses the process of grinding following floating to produce a “flat porous surface having a sanded characteristic” (col. 6, lines 50-52; col. 8, lines 8-10; col. 9, lines 30-32). Thus, Danielsson does not teach grinding to achieve uniformly exposed aggregate as required by the present claims and as alleged in the Office Action (p. 4). Rather, Danielsson consistently teaches grinding to produce a surface with a sanded quality. Next, Applicants remind the Examiner that Danielsson is not directed to providing an exposed surface flooring, but a subfloor upon which “tile, carpeting or the like” may be applied (see object of the invention at col. 5, lines 53-55). Applicants further submit that the teachings of the densification operation of Danielsson clearly establishes that the densification is employed to produce an upper layer of sand, concrete and water (col. 7, lines 38-40), such that a thin surface layer (col. 8, lines 7-9) can be removed to “produce a flat, porous surface having a sanded quality...” (col. 8, lines 8-10). Danielsson does not appear to teach the removal of aggregate in the grinding operation, and in fact specifically teaches densification so as to cause the

upper layer to be substantially free of aggregate. Applicants, once again, urge that such a teaching is contrary to the teachings of Shaw, and to the limitations set forth in the rejected independent claim 1. As a result of the contrary teachings of Shaw and Danielsson, Applicants respectfully maintain that the two patents are not properly combined and that *prima facie* obviousness has not been established. Accordingly, the rejection of independent claims 1 and 20 over Shaw in view of Danielsson is respectfully traversed.

Considering, *in arguendo*, a combination of Shaw and Danielsson, both fail to teach or suggest the recited limitation of grinding the upper surface of a partially cured concrete with the integrated aggregate therein. Absent a teaching of all claim limitations in the recited order (claim 1), or the teaching of only the recited limitations (claim 20), the rejection for obviousness is incomplete, and Applicants hereby traverse the rejection based upon an arguable combination of Shaw in view of Danielsson.

Turning next to the alternative rejection over Shaw in view of Harvey, Applicants note that Harvey similarly teaches away from the claimed invention, and Shaw as well, in that Harvey is directed to producing a finished floor surface that is poured in place over an existing subfloor (wood or concrete; col. 2, lines 39-43). In other words, Harvey teaches away from forming an integrated ornamental surface on a monolithic concrete floor as Harvey expressly teaches a decorative surface applied over an existing wood or concrete subfloor. Moreover, the additional steps required for the decorative surface taught by Harvey would result in secondary processes and additional costs as compared to Shaw, or the presently claimed invention – thus suggesting that it would not have been obvious to make the proposed combination.

In setting forth the rejection, the Examiner failed to indicate what motivation one of skill in the art would have had to combine the contradictory teachings set forth by Shaw and Harvey. In the event the rejection is maintained, Applicants respectfully request that the Examiner set forth what would have motivated one of skill in the art to make the proposed modification to Shaw in light of the contrary teachings set forth in the patents. Applicants further note that Harvey teaches air curing then “after drying,” grinding the top surface, and after sealing the dried surface is ground using sanding wheels (col. 3, lines 58-67). Here again, Harvey does not appear to teach fully curing the concrete and polishing the upper surface of the monolithic concrete

floor as recited in the independent claims. In view of the contrary teachings of Shaw and Harvey, and absent a showing of how the teachings of the patents can be combined to show all of the limitations of the rejected independent claims, *prima facie* obviousness has not been established. Hence Applicants traverse the rejection based upon a combination of Shaw in view of Harvey.

With respect to dependent claims 2-10, Applicants respectfully urge the various arguments set forth above relative to the independent claims and for the sake of brevity further distinctions are not set forth at this time. Applicants reserve the right to present arguments in support of such claims in a subsequent response or on appeal. The rejection of dependent claims 2-10 is also respectfully traversed.

Claim 11 was rejected under 35 USC §103(a) as being unpatentable over Shaw et al. (6,033,146) in view of Danielsson (4,281,496) or Harvey (6,566,146) and further in view of Surface Preparation (VIC International). Applicants incorporate herein the previously-noted arguments relative to the independent claims and the further rejection is respectfully traversed. Neither Shaw, Danielsson or Harvey teach the grinding up an upper surface of a partially cured monolithic floor with integrated aggregate using diamond heads, silicon carbide and a diamond pad. The addition of the Surface Preparation teachings show the polishing of cured concrete, and fails to teach or suggest the use of diamond cutting heads on partially cured monolithic concrete floors (as set forth in claim 11 – which further characterizes limitations of claim 1). Applicants maintain that the Examiner has failed to provide a teaching of every limitation set forth in claim 11 and thus *prima facie* obviousness has not been established. Accordingly, Applicants respectfully urge that the addition of Surface Preparation does not give rise to a teaching of the further limitations set forth in claim 11.

The rejection also relies upon conclusory statements such as “[t]herefore it would have been *prima facie* obvious ... to have employed conventional grinding means to progressively grind the surface of the concrete.... The combination suggests the specific selection of the means would have been optimized by the artisan” (Office Action p. 7). Applicants respectfully disagree and continue to urge that the Examiner failed to demonstrate a teaching of grinding partially cured concrete using diamond pads - as set forth in the first limitation of claim 11, for example. Accordingly, the rejection is respectfully traversed.

Claim 12 was rejected under 35 USC §103(a) as being unpatentable over Shaw et al. (6,033,146) in view of Danielsson (4,281,496) or Harvey (6,566,146) and further in view of Surface Preparation and still further in view of Jones (6,454,632). The rejection is respectfully traversed in view of the arguments presented above relative to claims 1 and 11. Applicants for the sake of brevity do not identify further distinctions or arguments in traversal, but reserve the right to do so in a subsequent response or upon appeal.

Claim 13 was rejected under 35 USC §103(a) as being unpatentable over Shaw et al. (6,033,146) in view of Danielsson (4,281,496) or Harvey (6,566,146) and further in view of Chiuminatta (5,088,750). Applicants respectfully traverse the rejection for the reasons set forth above relative to claim 1 as though incorporated herein in their entirety. For the sake of brevity Applicants respectfully reserve the opportunity to set forth additional limitations and arguments supporting traversal of the rejection of dependent claim 13 in a subsequent response or on appeal.

In view of the foregoing remarks and amendments, reconsideration of this application and allowance thereof are earnestly solicited. In the event that additional fees are required as a result of this response, including fees for extensions of time, such fees should be charged to USPTO Deposit Account No. 50-2737 for Basch & Nickerson LLP.

In the event the Examiner considers personal contact advantageous to the timely disposition of this case, the Examiner is hereby authorized to call Applicant's attorney, Duane C. Basch, at Telephone Number (585) 899-3970, Penfield, New York.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "DUANE C. BASCH".

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